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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,649	11/24/2003	Christian Weis	2001P80072WOUS	1173
28204	7590	07/13/2005	EXAMINER	
SIEMENS SCHWEIZ I-44, INTELLECTUAL PROPERTY ALBISRIEDERSTRASSE 245 ZURICH, CH-8047 SWITZERLAND			HANSEN, COLBY M	
			ART UNIT	PAPER NUMBER
			3682	
DATE MAILED: 07/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/718,649	WEIS, CHRISTIAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Colby Hansen	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 March 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 8, 9 and 15-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 8, 9, and 15-24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claim 21 is objected to because of the following informalities: “toque” must be changed to --torque--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's negative recitation of the intermediate member preventing the gear ring and hub from making direct contact must have basis in the original disclosure, mere absence of a positive recitation is not basis for an exclusion. Therefor any claim containing a negative limitation which does not have basis in the original disclosure is properly rejected under 35 USC 112, 1<sup>st</sup> paragraph as failing to comply with the written description requirement. MPEP 2173.05(i).

Claims 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. Applicant's addition of claims concerning the position of the hub, gear ring and intermediate member as well as the intermediate member being arranged to decouple have no clear antecedent basis within the original specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 9, and 15-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what the metes and bounds are of the term "peak torque".

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Becker et al. Becker et al. teaches in figure 1, an apparatus comprising, inter alia, an actuator connected to a wheel having a gear ring 34, a hub 36, and an elastic intermediate layer 44 connected to a mechanical element 20 which is connected to a movable element 22 wherein the position of the intermediate member prevents direct contact between the inner radial surface of 32 and an outer radial surface of 38, as broadly recited; additional the intermediate layer 44 allows for

uncoupling and coupling, as it initially couples, then should it experience an excessive force, it would shear, thereby uncoupling, as broadly recited (additionally, the intermediate layer 44 inherently absorbs ubiquitously “peak torque”).

***Claim Rejections - 35 USC § 103***

Claims 8, 9, 15-19, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 198 39 707 A1 in view of Becker et al.

DE 198 39 707 A1 discloses in figures 1 and 2, an apparatus comprising, an actuating device having a motor and a worm gear; a control disc 4 having a plurality of tracks located on opposite side of the control disc; two arms 101, 12 having extensions 11 extending into said plurality of tracks effecting a locking and releasing of a movable element (distal ends of said levers located away from ends thereof having the extensions). De 198 39 707 A1 does not discloses a wheel comprising a gear ring, a hub, and an elastic intermediate member located between said actuating device and said control disc. However, Becker et al. teaches in figure 1, an apparatus comprising, inter alia, an actuator connected to a wheel having a gear ring 34, a hub 36, and an elastic intermediate layer 44 connected to a mechanical element 20 which is connected to a movable element 22 wherein the position of the intermediate member prevents direct contact between the inner radial surface of 32 and an outer radial surface of 38, as broadly recited; additional the intermediate layer 44 allows for uncoupling and coupling, as it initially couples, then should it experience an excessive force, it would shear, thereby uncoupling, as broadly recited (additionally, the intermediate layer 44 inherently absorbs “peak torque”). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

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was made to modify the apparatus of DE 198 39 7077 A1 in view of the teachings of Becker et al. to provide a wheel having an elastic intermediate member so as to provide a certain amount of elasticity to guard against the shock of a reverse acting force of any kind and to suppress the propagation of vibration. See lines 36-41 of column 3 of Becker et al.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE 1983 39 707 A1 in view of Becker et al. as applied to claims 8, 9, 15-19, and 21-24 and further in view of Ginsberg. The reference combination set forth above discloses the basis apparatus but does not disclose first and second stop member. However, Ginsberg teaches in figure 1 an apparatus comprising, inter alia, a control disc 40 having a first stop member 43 which engages a second stop member 38a, 38b so as to halt the movement of said control disc. There, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of DE 198 39 707 A1 in view of the teachings of Ginsberg to provide first and second stop members so as to limit the amount of rotation and provide halt positions of said control disc so as to provide rest positions when said levers are actuated to desired positions; avoiding the continued locking and releasing with uninterrupted drive from said actuating device.

#### *Response to Arguments*

Applicant's arguments filed 3/14/2005 have been fully considered but they are not persuasive.

Applicant argues that the since the intermediate layer of Becker et. al was designed to damp reverse action forces, it does not absorb "peak torque" as applicant's invention does. As the broadest interpretation of the term "peak torque" would include the "peak" reversal forces,

Becker et al. is deemed to fulfill said limitation. Further, as the intermediate layer absorbs all forward and reverse forces between the gears, it will inherently absorb "peak forces" as understood by applicant (though not claimed by applicant).

### ***FACSIMILE TRANSMISSION***

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9306**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on \_\_\_\_\_

(Date)

Typed or printed name of person signing this certificate:

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(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colby Hansen whose telephone number is (571) 272-7105. The examiner can normally be reached on Monday through Thursday and every other Friday from 7:30 PM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (571) 272-7099. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Colby M. Hansen

 7/11/05  
Patent Examiner

 7/11/05  
DAVID A. BUCCI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600